

REMARKS

Claims 1-9, 15, 16, 21-39 and 41-51 are pending in this application.

Interview I

On 15 October 2003, the examiner called the applicant's representative, Robert E. Bushnell, to inform that the examiner found a reference for viscosities for various oils of ISO viscosity Grade and Tech Data for Petro Canada for the Trade name Purity with respect to teachings to the viscosity at 40 °C and the flash point for white mineral oils. The examiner stated that the reference supports the examiner's position that PURITY 50 has a viscosity of at least 50. The examiner said that she would fax the references to the applicant's representative.

The references were faxed to the applicant's representative on 15 October 2003, and were also mailed on 21 October 2003.

Interview II

On 16 October 2003, the examiner called the applicant's representative, Robert E. Bushnell, to inform that the Petition to Make Special filed on 25 April 2003 was located and routed to the department that will answer the Petition.

New References and 103 Rejection

The examiner cited two new references titled "ISO-viscosity System for Industrial Fluid

Lubricants" (hereinafter "ISO reference") and "Purity* FG WO White Mineral Oils." (hereinafter "Purity reference").

The ISO reference is not related to the patentability of the claims. It merely shows the ISO-viscosity System. The purity reference did not show the specification of the PURITY 50. The purity reference shows only "PURITY * FG WO 15," "PURITY * FG WO 35," and "PURITY * FG WO 90." There is no reason to believe that the viscosities of "PURITY * FG WO 15," "PURITY * FG WO 35," and "PURITY * FG WO 90." and the viscosity of PURITY 50 are the same. The examiner cannot assume it without a valid ground of the reasoning.

The examiner's attention is invited to consider the following point.

In response to the Office action (Paper No. 12), the applicant's response includes four arguments: (1) The examiner did not show that the claimed range of the viscosity of the hydrocarbon oil overlaps or lies inside ranges disclosed by the prior art; (2) The flash point or the viscosity of the hydrocarbon oil was not first recognized as a result-effective variable, which achieves a recognized result; (3) The present invention is patentable because of the ranges of the hydrocarbon oil and the copolymer; and (4) The "free standing" property is not inherent in the cited references.

According to MPEP §707.07(f), "[w]here the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. If a rejection of

record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.” (Emphasis added.)

Accordingly, even assuming that PURITY 50 has the viscosity in the claimed range, it is respectfully requested that the examiner’s answer to the substance of the applicant’s arguments (2)-(4) be included in the next Office action.

New Claims

Claims 52 to 56 have been newly added.

Support for claims 52 to 56 is repeatedly found in the original disclosure, particularly at pages 12-14 including Tables 1 and 2. No new matter has been added.

To expedite the prosecution, the examiner’s attention is invited to consider the following points. The following arguments should not be interpreted as that the claims have only the recited novel or nonobvious feature.

The examiner’s attention is invited to consider the following points, in addition to the applicant’s arguments in the previously submitted Responses.

With respect to claims 52 to 56, the claim body recites the feature of the candle which maintains a free standing condition when the candle is lit.

With respect to claim 52, claim 52 recites the density of the hydrocarbon oil, not less than 0.88kg/L at 20 °C. Table 1 on page 12 shows that the density of the hydrocarbon oil used is 0.88kg/L

at 20 °C. The specification discloses that, in order to prepare the present invention, “hydrocarbon oils are used that have the feature of remaining liquid within a temperature range between 0 °C (32 °F) and 200 °C (392 °F), as well as the condition of being transparent and of high density” (page 14, lines3-5). The feature of the density of the hydrocarbon oil, not less than 0.88kg/L at 20 °C is not taught or suggested explicitly or implicitly in the prior art.

With respect to claim 53, the scope of claim 53 explicitly excludes the candle with a container for holding the candle when the candle is lit. Since both the Morrison patents and the Camp patent use the container for holding the candle when the candle is lit. Two references do neither teach, nor suggest, nor recognize the candle which can free stand even when the candle is lit. There is no suggestion or motivation to remove the container used in the Morrison patents and the Camp patent.

With respect to claim 54, the copolymer used for the candle is specifically defined. This feature is not taught or suggested by the prior art.

With respect to claim 55, the viscosity and the flash point of the hydrocarbon oil are more narrowly defined. These features are not found in the prior art. With respect to claim 56, the proportions of the hydrocarbon oil and the copolymer in claim 55 are further defined.

In order to “inherency rejection,” the examiner must show that the same composition is used in the cited references taken separately or in combination. Otherwise, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly “free standing” characteristic, when the candle is lit, **necessarily** flows from the teachings of the applied prior art to rely upon the theory of inherency. (“In relying upon the theory of inherency, the

examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

A fee of \$131.00 is incurred by the addition of two (2) independent claims in excess of nine (9) and five (5) claims in excess of 41. Applicant's check drawn to the order of Commissioner accompanies this Response. Should the check become lost, should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Should a Petition for extension of time be required with the filing of this Amendment, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if a check of the requisite amount is not enclosed.

Respectfully submitted,



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